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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Ronald G. Parkinen, et al.

Serial No.: 09/560,722

Filing Date: 04/28/2000

For: VIDEO RECORDING SYSTEM
UTILIZING EXTERNAL VIDEO STORAGE
TO RECORD STREAMING VIDEO DATA
VIA AN ISOCHRONOUS INTERFACE

Art Unit: 2621

Examiner: Huy Thanh Nguyen

Confirmation No.: 5247

Docket No.: K35A0604

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants request a pre-appeal review of the legal and factual basis of the rejections in the Final Office Action. No amendments are being filed with this request, and this request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the following sheets.

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REASONS FOR THE REQUESTED REVIEW

In the Final Office Action of September 18, 2006, the Examiner rejects Claims 22-37 under 35 USC §103(a) as being unpatentable over various combinations of prior art references. Applicants respectfully submit that these claims should be allowed for the reasons given below.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 22, 26-27, 29-31, and 35 stand rejected under 35 USC 103(a) as unpatentable over U.S. Pat. No. 5,991,832 to Sato *et al.* (*Sato*) in view of U.S. Pat. No. 5,241,428 to Goldwasser *et al.* (*Goldwasser*). Claims 23-25, 28, 32-34, and 36-39 stand rejected under 35 USC §103(a) as unpatentable over *Sato* in view of *Goldwasser* and further in view of one or more of the following references: U.S. Patent No. 5,990,927 issued to Hendricks *et al.* (*Hendricks*); U.S. Patent No. 6,016,507 issued to Carroll *et al.* (*Carroll*); U.S. Patent No. 5,815,631 issued to Sugiyama *et al.* (*Sugiyama*); or German Patent No. DE 3106125 A1 issued to Wieland (*Wieland*). Applicants respectfully request review and reversal of the rejections of Claims 22-37 based on (1) the failure of the cited combination of references to teach all of the claim limitations of the rejected claims (see *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP § 2143.03) and (2) the Examiner's failure to provide a motivation to combine the references, and specifically, the failure to consider *Sato* in its entirety, including portions that would lead away from the claimed invention (see *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); MPEP § 2141.02(VI)).

ARGUMENTS

1. The cited combination of references fails to teach all of the claim limitations

Independent Claim 22 recites "a video data management system that: uses the electronic program guide to select the video program segment in response to the user input and to control playback commands of the video data management system ... and routes the selected portion of the streaming video data to the external hard disk drive

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via the isochronous interface in order to record the external video data stream for the video program segment, wherein the playback commands are usable while the external video data stream is being recorded." Independent Claim 35 recites "using the electronic program guide to select the video program segment in response to the user input and to control playback commands of the external video data stream" and "routing at least a portion of the streaming video data to the external hard disk drive via the isochronous interface in order to record the external video data stream for the video program segment, wherein the playback commands are usable while the external video data stream is being recorded." All other pending claims depend directly or indirectly on either Claim 22 and or Claim 35 and inherently include the limitations of either Claim 22 or Claim 35. Thus, if the quoted limitations are not shown by the cited combination of references, then the cited combination of references fails to render any of the pending claims obvious.

In response to the cited combination of references being raised by the Examiner in a previous Office Action (non-final Office Action mailed 02/02/06, pp. 3-5), Applicants argued that neither *Sato* nor *Goldwasser* teaches the quoted limitations (see Applicants' response filed 07/03/06, pp. 7-8). In particular, Applicants pointed out that the only recording device with the electronic program guide of *Sato* is a video tape recorder, which records on a sequential medium that does not allow the use of playback commands while recording. And although *Goldwasser* shows the use of a random access (non-sequential) medium to record broadcasts, *Goldwasser* does not show the use of playback commands in an electronic program guide, nor does any of the other art of record in the present Application.

The Examiner's response to Applicants' arguments fails to provide any adequate basis for rejecting Applicants' arguments with respect to the *Sato-Goldwasser* combination. In response to Applicants' arguments that the *Sato-Goldwasser* combination does not teach an electronic program guide with playback commands usable during recording of the external video data stream, the Examiner merely states "it is noted applicant argument does not reflect the claims since the claims do not specify that the playback command in EPG are usable during recording" (Final Office

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Action mailed 09/18/06, p. 10). But Claims 22 and 35 both clearly state that the electronic program guide is used "to control playback commands of the external video data stream" with the further limitation that "the playback commands are usable while the external video data stream is being recorded." The antecedent basis for the term "the playback commands" is found in the playback commands controlled by the electronic program guide. Consequently, the Examiner's assertion that Applicants' arguments do not reflect the claim language is inaccurate, and the quoted limitations are in fact not taught in the cited combination of references. Accordingly, Applicants respectfully submit that Claim 22, Claim 35, and the other pending claims that depend directly or indirectly on these claims should be allowed.

2. There is no motivation to combine the references when each is taken in totality:

Even if the *Sato-Goldwasser* combination or some other combination of the references of record did teach all of the limitations of the independent claims, there would still be no motivation found in the references themselves to make such a combination. Applicants pointed out in a previous response (see Applicants' response filed 07/03/06, p. 8) that *Sato* specifically teaches that the electronic program guide should not distinguish between playback of recorded programs and broadcast programs in order to raise the degree of usage convenience. Indeed, *Sato* explicitly states "according to the present embodiment, either a broadcasted program or a program recorded in advance can be selected in such a uniform manner that there is no need to distinguish one from another, raising the degree of usage convenience of the system" (*Sato*, Col. 5, lines 12-16; see also col. 6, lines 44-49). The use of playback commands for recorded programs in the electronic program guide would clearly distinguish broadcast programs from recorded programs; thus, *Sato* clearly teaches away from the combination.

The Examiner has provided no response to Applicants' arguments that *Sato* teaches away from the combination. Nor has the Examiner cited any motivation in any of the other references to suggest the use of playback commands in an electronic program guide. Given that *Sato* clearly teaches away from use of playback commands

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in an electronic program guide and that the Examiner has provided no motivation for the combination or even an explanation as to why *Sato* does not explicitly teach away from the combination, the rejection of the pending claims based on the combination of other references with *Sato* is clear error. Applicants respectfully submit that this is an independent and sufficient basis for Claims 22-39 to be allowed and respectfully request allowance of Claims 22-39 for this reason in addition to the reasons given above.

CONCLUSION

For the foregoing reasons, Applicants request reversal of all rejections under review and allowance of all pending claims.

The Commissioner is hereby authorized to charge payment of any required fees associated with this Communication or credit any overpayment to Deposit Account No. 23-1209.

Respectfully submitted,

Date: January 16, 2007

By: 

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